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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/868,619	09/25/2001	Yasuhito Sone	P107390-0000	1036

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EXAMINER

JABR, FADEY S

ART UNIT	PAPER NUMBER
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3628

DATE MAILED: 10/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/868,619	Applicant(s) SONE, YASUHIITO	
	Examiner Fadey S. Jabr	Art Unit 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>8/14/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

Claims **1 and 6-10** have been amended. Claims **1-3 and 5-10** remain pending and are again presented for examination.

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9 August 2006 has been entered.

Response to Arguments

2. Applicant's arguments with respect to claim **1-3 and 5-10** have been considered but are moot in view of the new ground(s) of rejection.

3. Applicant argues that Hassett does not disclose indicating a purchase date and time for transactions. However, Examiner asserts that Hassett discloses whenever a date is required, fields can be date and time stamped in a year-month-day-hour-minute-second format. (C. 18, lines 19-21)

4. Hassett et al. discloses the claimed invention except for a number of storage areas. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have separate storage areas for different types of data, since it has been held that mere

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duplication of the essential working parts of a device, without more, involves only routine skill in the art. Further, the claim lacks any recitation claiming that the storage areas are separate storage areas, and read in the broadest reasonable interpretation, the storage areas are one storage area containing all of the data.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims **1, 3 and 10** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per **Claim 1 and 10**, the recitation “wherein the sales to date comprise total sales to date to a plurality of users” is vague and indefinite. It is unclear to the Office what the Applicant is attempting to claim. Further, the recitation “wherein the larger the total sales to date is, the larger the initial number of times of unitary use is set, and the more rapidly the total sales to date increases, the more rapidly the initial number of times of unitary use increases” is vague and indefinite. It is unclear to the Office how total sales increasing rapidly, rapidly increases the number of unitary use. Appropriate correction in the indicated claims and any subsequent claims is required.

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As per **Claim 3**, the recitation “the initial value-setting means *sets one and the same number for all media...*” is vague and indefinite. It is unclear to the Office what the Applicant is attempting to claim. Appropriate correction in the indicated claims and any subsequent claims is required.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims **1-3 and 5-10** are rejected under 35 U.S.C. 103(a) as being unpatentable over Hassett et al., U.S. Patent No. 5,144,553 in view of Park et al, U.S. Patent No. 6,091,344 A1 and Wyker, Pub. No. US2001/0047296 A1.

As per **Claim 1, 2 and 10**, Hassett et al. discloses a system comprising

- a means for receiving purchase-application data on each medium including its purchase date and time through a communication network (Col. 4, lines 13-27, 44-48; Col. 17, lines 1-21),
- a storage area for storing the opening date and time of advance sale (automated toll debit transactions) of the media (Col. 5, lines 64-67; Col. 16, lines 33-68; Col. 18, lines 10-21),

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- a storage area for storing the closing date and time of the advance sale (Col. 5, lines 64-4; Col. 16, lines 33-68; Col. 18, lines 10-21),
- a storage area for storing the closing date and time of ordinary sale (toll amount purchases), as distinct from the advance sale, of the media (Col. 5, lines 64-4; Col. 16, lines 33-68; Col. 18, lines 10-21), and
- storage area for storing a target annual sales of the media (Col. 5, lines 64-68; Col. 16, lines 33-59),
- a storage area for storing a selling price of media, a storage area for storing a toll expressed in a number of times of unitary use of the service (Col. 5, lines 64-68; Col. 16, lines 33-59),
- a storage area for storing a most preferential initial number of times of unitary use applicable to media purchased during the advance sale (Col. 5, lines 64-68; Col. 16, lines 33-59), and
- a storage area for storing sales to date from the opening date and time to the purchase date and time of each medium (Col. 5, lines 64-68; Col. 16, lines 33-59),
- an initial value-setting means for setting the initial numbers of media with purchase dates and times between the opening and closing dates and times of the advance sale higher than those of media with purchase dates and times between the closing dates and times of the advance and ordinary sales (Col. 4, lines 44-61; Col. 16, lines 33-59).
- the initial value-setting means having :
 - a function f.sub.1 to calculate the number of days from the closing date and time to the purchase date and time of each media,

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- a function f.sub.2 to calculate a preferential initial number of times of unitary use at the purchase date and time of said medium based on the number of days, the most preferential initial number of times of unitary use, and the toll,
- a function f.sub.3 to calculate the ratio of the preferential initial number of times of unitary use of said medium to the target annual sales of the media, and
- a function f.sub.4 to calculate the final initial number of times of unitary use for said medium based on the ratio and the sales at the purchase date and time of said medium (Col. 17, lines 1-54).

Hassett et al. fails to explicitly disclose setting the initial numbers of media higher with purchase dates during an earlier time period. However, Park et al. teaches a toll collecting system with discount cards (C. 7, lines 29-54). Furthermore, Wyker teaches a promotion period where a discount is applied to the item for consumes thereby establishing a target sales price less than the reduced retail sales price of the item (0036). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the system of Hassett et al. and include providing a discount to toll users and providing a discount if the item was purchased during a promotional period as taught by Park et al. and Wyker, because it would encourage customers to purchase the item during the specified period.

Hassett et al. discloses a system for collecting, replenishing and managing toll transaction comprising storage modules for storing transaction data (C. 16, lines 33-67). Furthermore, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). A

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claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd Pat. App & Inter. 1987). Thus, the structural limitation of claims 1 and 10, including storage areas are disclosed by Hassett et al. as described above. Also, as described above, the functional limitations in claims 1 and 10 do not distinguish the claimed apparatus from the prior art.

As per Claims 3, Hassett et al. fails to explicitly disclose a system which the initial value-setting means sets one and the same number for all media with purchase dates and times between the opening and closing dates and times. Official notice is taken that charging customers who purchase the identical item at the same location during the corresponding time period are billed equally is old and well known in the art.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the system of Hassett et al. to include the initial value-setting means sets one and the same number for all media with purchase dates and times between the opening and closing dates and times, because Hassett et al. discloses vehicle operators purchasing prepaid toll-money-available quantities (Col. 5, lines 64-68), one of ordinary skill in the art would be motivated to do so, because it greatly benefits the system to charge the optimum price determined by economic forces.

As per **Claim 5**, Hassett et al. further discloses a device which is a computer and provided with the initial value-setting system (Col. 16, lines 60-68; Col. 17, lines 1-21).

As per **Claims 6**, Hassett et al. further discloses a system which sets the initial available numbers of times of unitary use of the media and has a means for transmitting the initial numbers, purchase-application-data input devices each to input and transmit purchase-application data on each medium to the initial value-setting device through a communication network N, writing devices each to receive the initial number of each medium from the initial value-setting device through the communication network N and write the initial number in said medium, and rewriting devices 4 each to rewrite the remaining available number of times of unitary use of said user's medium every time each user makes use of the service (Col. 78, lines 6-68; Col. 8, lines 1-2, 24-44; Col. 16, lines 33-35, 60-67).

As per **Claim 7 and 8**, Hassett et al. further discloses a system which

- sets the initial numbers of times of unitary use of the media and has a means for transmitting the initial numbers (Col. 16, lines 60-68),
- (ii) mobile communication terminals each including a means for inputting purchase application data on a medium (Col. 4, lines 13-27, 44-48),
- a means for transmitting the purchase-application data on the medium to the initial value-setting device through a communication network, a means for receiving the initial number of the medium from the initial value-setting device through the communication network (Col. 16, lines 56-68),

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- and a means for writing the initial number in the medium, and (iii) a rewriting device to rewrite the remaining available number of times of unitary use of said user's medium every time each user makes use of the service (Col. 2, lines 27-30, 41-61).

As per **Claim 9**, Hassett et al. further discloses a medium for a plurality of users who make use of a certain toll or pay service which is a storage medium to be used in the operating system according to claim 6, and has a rewritable storage area of a number of times of unitary use (Col. 2, lines 27-30, 41-61).

Conclusion

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fadey S. Jabr whose telephone number is (571) 272-1516. The examiner can normally be reached on Mon. - Fri. 7:30am to 4:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571) 272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Fadey S Jabr
Examiner
Art Unit 3628

FSJ

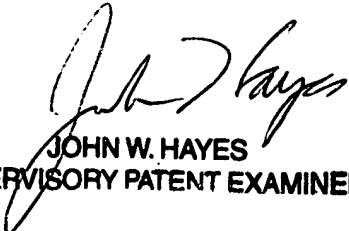
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(571) 273-1516 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to the Customer Service Window, Randolph Building, 401 Dulany Street, Alexandria, VA 22314


**JOHN W. HAYES
SUPERVISORY PATENT EXAMINER**